

Appl. No. : 10/038,098
Filed : October 19, 2001

REMARKS

In the Final Office Action mailed on March 28, 2006, the Examiner maintained the rejection of Claims 1-3, 6-19 and 22-34 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. Pub. 2002/0120727 ("Curley et al."). The Final Office Action lists the rejected claims as 1-34, which is incorrect since Applicants previously canceled Claims 4, 5, 20, and 21.

In maintaining the rejection, the Examiner indicated that the Declaration under 37 C.F.R. 1.131 of inventor Noam Fraenkel is not sufficient for swearing behind Curley et al. In connection with this issue, the Examiner pointed out that the Declaration is signed by only one of the four inventors. In addition, the Examiner asserted that the Declaration does not include sufficient evidence that Applicants' product worked, and that the invention was therefore reduced to practice, as of June 2000.

In response to the Final Office Action, Applicants are submitting the Declarations of the other three inventors, Guy Goldstein, Ido Sarig, and Refael Haddad. These Declarations include additional evidence that the claimed invention was successfully reduced to practice no later than June of 2000 as part of Mercury Interactive Corporation's Topaz 2.0 product. For example, the Declaration of Ido Sarig states the following:

7. As part of our pre-public-release testing of Topaz 2.0 prior to June of 2000, we verified that the transaction breakdown feature worked for its intended purpose. This testing included executing actual web site transactions with a Topaz 2.0 agent, and in connection with these transactions, verifying that the Topaz 2.0 agent accurately performed the functions described in the preceding paragraph. See Exhibit D, discussed below.

12. Attached as Exhibit D is a PowerPoint slide with a transaction breakdown report generated by the Topaz product from actual test data collected between April 9, 2000 and April 15, 2000. This report was generated using the process claimed in the present application in April of 2000, and shows that the Transaction Breakdown feature was operational (performed its intended function) at that time.

13. The transaction breakdown feature of Topaz 2.0 was successfully used for its intended purpose in the United States, both by Mercury and its customers, no later than June of 2000.

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Other evidence of Applicants' actual reduction to practice is included throughout the Declarations of the four inventors and the associated exhibits.

Because the Declarations of the four inventors show an actual reduction to practice prior to the effective date of Curley et al., no showing of diligence is required. See MPEP 715.07, subsection III ("Three Ways to Show Prior Invention").

Claims 1-3, 6-19, 22, 23 and 25-34

With respect to Claims 1-3, 6-19, 22, 23 and 25-34, Applicants submit that the rejection is improper because Curley et al. is not "prior art" to these claims. In support of their position, Applicants are relying on the sworn Declarations under 37 C.F.R. 1.131 of the four named inventors, Noam Fraenkel, Guy Goldstein, Ido Sarig, and Refael Haddad, and the exhibits to those Declarations. These materials show the following (1) Mercury Interactive Corporation, the assignee of the present application, developed, tested and publicly launched a software product known as Topaz 2.0 no later than June of 2000; and (2) this product, as launched and used in the United States no later than June of 2000, embodied all of the limitations of Claims 1-3, 6-19, 22, 23 and 25-34, and represented an actual reduction to practice of these claims. Because these claims were reduced to practice prior to the December 21, 2000 filing date of Curley et al., Curley et al. is not prior art to any of these claims.

Claim 24

With respect to Claim 24, Applicants respectfully submit that the rejection is improper because Curley et al. does not inherently or explicitly disclose "a component that analyzes data collected by the agent component to identify correlations in time between degradations in transaction response times and degradations in the components of such transaction response times, to thereby facilitate identification of causes of end user performance problems." Applicants' representative has carefully reviewed the paragraphs of Curley et al. cited by the Examiner (namely 0133, 0140, 0163, 0215, 0232, 0252 and 0256), and does not believe the feature recited in Claim 24 is disclosed.

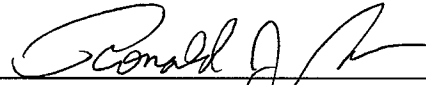
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In view of the foregoing remarks and the Declarations discussed above, Applicants submit that the application is now in condition for allowance. If, however, any issues remain which can potentially be resolved by telephone, the Examiner is invited to call the undersigned attorney of record at his direct dial number of 949-721-2950.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9-28-06

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